

Remarks

In view of the foregoing amendments and the following remarks, favorable reconsideration and withdrawal of the rejections set forth in the Office Action dated November 29, 2007, are respectfully requested.

Claims 1-11, 27, and 29 are pending, of which Claims 1 and 29 are independent. Claim 28 has been cancelled, and new Claim 29 has been presented. Support for the new claim can be found in the original disclosure. Therefore, no new matter has been added.

Allowable Claims

Applicants would like to thank the Examiner for indicating dependent Claims 5 and 6 as allowable if rewritten in independent form. These claims have not been rewritten, however, because the claims from which they depend are believed to be allowable for the following reasons.

Double Patenting Rejection

Claims 1-4, 7-11 and 29 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 12 of U.S. Patent No. 6,692,503 (Foley et al.) in view of U.S. Patent No. 5,676,666 (Oxland et al.) This rejection is respectfully traversed.

Foley et al. issued from U.S. Patent Application No. 09/907,022, of which this application is a divisional. During the prosecution of that patent, a restriction requirement was made on September 27, 2002, alleging that the bone fixation system was a

distinct invention from the drill guide. In response, Applicants elected to prosecute the claims directed to the drill guide in Application No. 09/907,022, and filed the present application with claims directed to the bone-fixation system. Moreover, this application was filed on August 20, 2003, prior to the issuance of the parent on February 17, 2004. Accordingly, Applicants submit that the double patenting rejection is improper and prohibited under 35 U.S.C. § 121, and request that the rejection be withdrawn. *See* MPEP 804.01.

35 U.S.C. § 112, Second Paragraph, Rejection

Claim 28 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have cancelled this claim, rendering this rejection moot.

35 U.S.C. § 103(a) Rejection

Claims 1-4, 7-11, 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,342,057 (Brace et al.), in view of Oxland et al. This rejection is respectfully traversed.

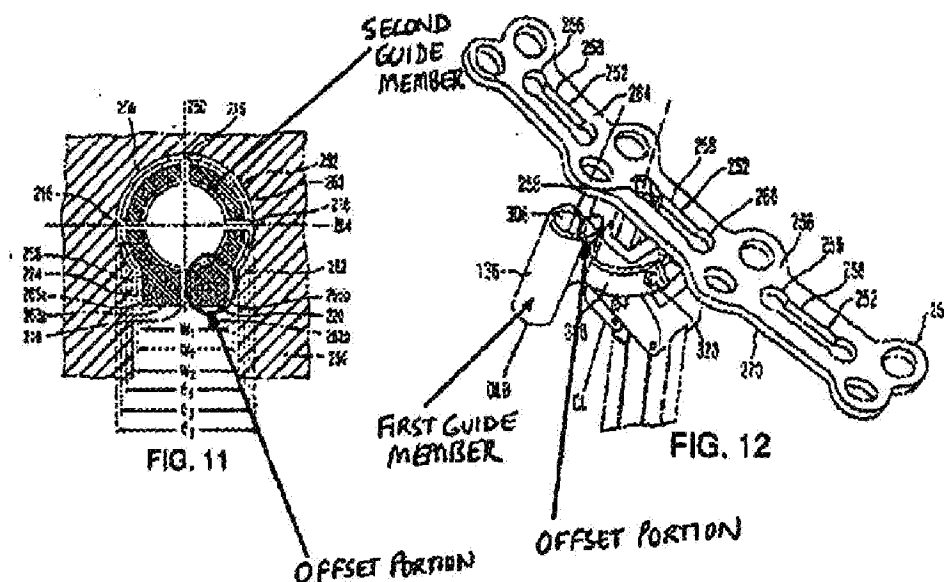
Applicants' invention as set forth in Claim 1 relates to a bone fixation system having a plate with a plurality of openings and a drill guide. One notable feature of the claim is that the drill guide has first and second guide members each having offset portions. These offset portions are positionable in a corresponding slot and configured to

contact a first end of the corresponding slot, which causes a fastener inserted into a hole through the slot to be displaced from the first end of the slot.

According to the Office Action, Brace et al. teaches all the elements of the claim except for a bone plate having fastener holes with an elliptical shape. Applicants respectfully disagree.

First, Brace et al. is deficient in a teaching or suggestion that each guide member includes an offset portion positionable in a corresponding one of the first and second slots, as generally recited in independent Claim 1.

Brace et al. teaches a surgical drill guide assembly 100 with drill tubes 134 and 136 and an expandable bushing 206. The Office Action characterizes drill tube 136 as the claimed first guide member, and characterizes expandable bushing 206 as the claimed second guide member. Provided below are the diagrams from the Office Action illustrating the Examiner's position.



As can be seen from above, while expandable bushing 206 may be positionable in a slot in the bone plate, drill tube 136 (or 134) is not designed to fit in a slot of the bone plate. In fact, the drill tube is disclosed to be *remotely* aligned with corresponding fastener holes in the bone plate (*see* Abstract). Moreover, the drill tube has a shape which would appear to prevent it from fitting in a slot of the bone plate. Accordingly, Brace et al. fails to teach or suggest two guide members each including an offset portion positionable in a corresponding one of the first and second slots, since only one of the relied upon structures, at most, is capable of being positioned in a slot at all.

Second, Brace et al. is deficient in a teaching or suggestion that each offset portion is configured to contact the first end of a corresponding slot (in the direction of the central axis), as recited in independent Claim 1.

The Office Action generally addresses the “configured to” language as follows:

...it is noted that edges 265a and 265b of the offset portions of Brace et al. are configured to contact an end of the slot (see Fig. 12). Notwithstanding this, it is noted that the limitation “configured to contact said first end of said corresponding slot” only requires the capability of the offset portions to contact the first end of the slot and is not a positive limitation and does not constitute a limitation in any patentable sense.

Response to Arguments, Office Action dated November 29, 2007, pages 5 and 6.

The referenced edges 265a and 265b are part of bushing 206, shown in Fig. 11, and not of drill tube 136. Because, as discussed above, drill tube 136 does not enter a slot, by definition it cannot have an offset portion which contacts an end of a slot.

To begin, Applicants submit that claim language reciting that a structure is “configured to” perform a certain function should be given patentable weight if it limits a claim to a particular structure. *See* MPEP § 2111.04. Thus, because Claim 1 recites guide members with a physically defined offset portion, which offset portion is configured to perform the function of contacting a first end of the slot, the recitation is to a particular structure that should be given patentable weight.

Furthermore, with respect to bushing 206, edges 265a and 265b do not contact an end of a slot as defined by the claim. Instead, as can be seen in Figure 11, those edges are on a side opposite to that which contacts an end of the slot and do not contact the end of the slot. In addition, Applicants submit that edges 265a and 265b cannot be broadly viewed to be configured to contact the end of a slot. In Applicants’ view, the relied upon structure does not appear capable of performing the claimed function. For instance, if bushing 206 was rotated 180° to have edges 265a and 265b nearer the end of the slot, it appears that bushing 206 would not fit in the slot, because its footprint would no longer mate with the shape of the slot. Accordingly, Applicants submit that the bushing 206 of Brace et al. cannot be said to be configured to contact a first end of a slot, as recited in independent Claim 1.

Therefore, by virtue of the drill tube of Brace et al. not even being positionable in a slot, that feature fails to suggest the guide members recited in independent Claim 1. In addition, by virtue of the expandable bushing not being configured to contact a first end of a slot, the bushing of Brace et al. cannot be said to teach or suggest the guide members. Accordingly, Applicants request withdrawal of this rejection.

The secondary citation to Oxland et al. was relied upon for teaching elliptically-shaped holes. This citation, however, is not understood to compensate for the above-noted deficiencies with respect to Brace et al.

New Claim 29

New Claim 29 recites features similar to independent Claim 1, but recites that when the first and second guide members are inserted into the first and second slots, each of the offset portions contacts the first end of the corresponding slot to space an adjacent edge of a hole formed through the guide member along the corresponding slot away from the first end of the slot. As such, any position taken with respect to the “configured to” language is believed to be moot with respect to new Claim 29.

Conclusion

For the foregoing reasons, Applicants respectfully submit that the present invention is patentably defined by independent Claims 1 and 29. Dependent Claims 2-11 and 27 are also patentable by virtue of their dependencies on an allowable claim, as well as for the additional features they recite. Individual consideration of the dependent claims is requested.

Applicants submits that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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